



GTX-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Marvin T. Ling
Serial No. : 09/553,695 Confirmation No. 6472
Filed : April 21, 2000
For : METHODS AND APPARATUS FOR CONDUCTING
ELECTRONIC COMMERCE TRANSACTIONS USING
ELECTRONIC TOKENS
Group Art Unit : 3628
Examiner : Frantzy Poinvil

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AMENDED APPEAL BRIEF

Nicola A. Pisano
Registration No: 34,408
Attorney for Appellant

LUCE, FORWARD,
HAMILTON & SCRIPPS, LLP
11988 El Camino Real, Ste 200
San Diego, California 92130
Tel.: 858.720.6320
Fax.: 858.523.4326

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Introduction

This brief is filed pursuant to 37 C.F.R. § 41.37 to appeal the Final Rejection dated May 19, 2005, of claims 1-27 of the above-identified application. **A request for oral hearing on this matter was filed with the Notice of Appeal on April 1, 2003.**

(1) Real Party In Interest

The real party in interest in this proceeding is the assignee of the present application, PayByClick Corporation, 15333 North Pima Rd., Suite 105, Scottsdale, Arizona 85260. PayByClick Corporation holds all right, title and interest in and to the present invention and pending application by virtue of an assignment dated August 7, 2002, recorded in the United States Patent and Trademark Office on November 25, 2002, at Reel 013267, beginning at Frame 0029.

(2) Related Appeals And Interferences

None currently pending.

Appellant notes that this application was the subject of a Notice of Appeal filed on April 1, 2003 based on a Final Action dated October 2, 2002. An Appeal Brief was filed on June 2, 2003. Responsive to filing of that Brief, prosecution was reopened and additional new prior art was cited by the Office.

(3) Status Of Claims

Claims 1-28 are pending in the application.

Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dorrough et al., U.S. Patent No. 5,287,269 ("Dorrough") in view of Williams et al., U.S. Patent No. 5,815,657 ("Williams") or Hill, U.S. Patent No. 6,236,981 ("Hill").

Claim 28, which depends from dependent claim 10, was newly added in Appellant's Reply to Office Action filed February 4, 2005. The Final Rejection does not address claim 28. Appellant assumes that the Examiner intended to reject new claim 28 also. If this is incorrect, Appellant respectfully requests clarification of the status of claim 28.

Therefore, the rejection of all of claims 1-28 is appealed herein.

(4) Status Of The Amendments

No amendments have been filed subsequent to the Final Action.

(5) Summary Of Claimed Subject Matter

The present invention relates to electronic commerce arrangements in which electronic tokens are issued to a registered user for use in purchasing goods and services at a vendor's website. As set forth in independent claims 1 and 27, a user may establish an account with a vendor, wherein the user provides the vendor with credit and address information during an initial registration step. The account is established without creating any physical manifestation of the account, other than a database entry. The vendor then issues electronic tokens having a value of at least a fraction of a dollar, and credits those tokens to the user's account. See, e.g., specification at page 8, lines 6-25, page 11, lines 8 to page 12, line 13, page 17, line 29 to page 21, line 6, and FIGS. 3-4.

As further recited in claims 1 and 27, the vendor provides through its website goods and services for sale that are denominated in units of tokens, and permits a registered user to select amongst these goods and services for purchase from any participating vendor web site. The total price of any proposed

sale is computed at the participating vendor web site in units of electronic tokens. See, e.g., specification at page 8, lines 26-31, page 23, line 3 to page 26, line 16, page 27, line 25 to page 31, line 18 and FIGS. 6-9.

Claims 1 and 27 also recite that a purchase transaction is authorized at the participating vendor web site without requiring any third party authentication and a physical manifestation of the user account. See, e.g., page 8, lines 1-5, page 25, line 6 to page 27, line 7, and FIG. 5.

Further, as recited in claims 1 and 27, if the user's account contains electronic tokens having a value greater than or equal to the proposed total price, the user may make the purchase without requiring the user to disclose personal information to the vendor to complete the transaction. See, e.g., specification at page 8, line 32 to page 9, line 8, page 26, line 17 to page 27, line 24, page 31, line 19 to page 34, line 12 and FIGS. 5 and 10.

Claims 1 and 27 also recite that the purchase transaction is not subject to a minimum processing fee. See, e.g., page 4, lines 1-11, and page 12, lines 25-32.

The principal advantages of the methods and apparatus of the present invention, as recited in the claims and described in the specification, are two-fold:

First, the methods and apparatus of the present invention make electronic commerce transactions at micropayment amounts cost-effective. A micropayment is a payment issued for the cost of a good or service that is typically below one dollar, and more frequently, only a few cents. The present invention makes such transactions commercially practicable by permitting the vendor to issue tokens to a registered user ***without requiring communication with a financial institution for each transaction.*** As described in the specification at page 7, lines 29-34 and

page 12, lines 14-32, this feature reduces overhead for the vendor (and ultimately the consumer) by reducing per-transaction charges. For example, a vendor may choose to accumulate multiple small charges before seeking reimbursement from a credit card company. Compare, specification at page 6, line 14 to page 7, line 8.

Second, the methods and apparatus of the present invention enable electronic commerce transactions to be conducted with significantly reduced risks to the user's privacy, compared to previously known systems. As recited in the claims and described in the specification, it does this by permitting transactions to be conducted between a registered user and the vendor **without** requiring the user to provide sensitive credit or personal information **in connection with each transaction**. See, specification at page 3, lines 28-31, page 11, lines 22-32 and page 12, line 33 to page 13, line 14. Importantly, because the user does not have to transmit sensitive credit or personal information during each purchase transaction, the risk that this information could be intercepted by a third party is significantly reduced, and privacy correspondingly enhanced. See, specification at page 13, lines 1-9. Indeed, if a user should elect an off-line method to initially establish his or her user account, as described in the specification at page 19, line 22 to page 20, line 16 (and the left hand column in FIG. 3), the user is never required to provide his or her credit information on-line.

(6) Grounds of Rejection To Be Reviewed On Appeal

Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dorrough et al., U.S. Patent No. 5,287,269 ("Dorrough") in view of Williams et al., U.S. Patent No. 5,815,657 ("Williams") or Hill, U.S. Patent No. 6,236,981 ("Hill").

(7) Argument

A. The Pending Claims Patentably Distinguish Over Dorrough, Williams, and Hill

(i) The Rejections

Appellant respectfully submits that the pending claims patentably distinguish over the prior art relied upon in the Final Office Action. As noted above, in the Office action dated May 19, 2005, claims 1-27 were rejected as obvious over Dorrough in view of Williams or Hill.

In appellant's Reply to Office Action mailed February 4, 2005, appellant amended claim 1 to recite:

"issuing one or more electronic tokens from the vendor to the user account, wherein no physical manifestation, other than a database entry, of the user account occurs, each electronic token having a value of at least a fraction of a dollar";
"permitting the user to select, at any participating vendor web site, a subset of the products and service for purchase from the vendor;
computing at the participating vendor web site a total price for the selected subset of the products and services in units of electronic tokens;
authorizing a purchase transaction at the participating vendor web site without requiring any third party authentication and a physical manifestation of the user account ... wherein the purchase transaction is not subject to a minimum processing fee" (emphasis added).

Appellant incorporated corresponding amendments into claim

(ii) The Dorrough Patent

Dorrough discloses an access control system and method for accessing events, areas, and activities. The control system requires a *physical manifestation of the account*, in the form of an access card, which is used in conjunction with various access stations. An access station is associated with each activity and reads an access card to open a customer account file. Each access station generates a debt signal corresponding to a selected cost for respective activities. An approval or disapproval is generated depending on a customer account credit. The access station receives the approval or disapproval signal from a comptroller processor. The access station then grants or denies a customer's access to the activity. See, e.g., columns 3-5, and FIGS. 1-5.

(iii) The Williams Patent

Williams discloses an electronic monetary system that emulates a wallet or purse containing several payment instruments that may be selected by a user when making electronic commerce purchases. Each payment instrument in the wallet is issued by a financial institution and is controlled by issuance of a certificate by the financial institution. See, e.g., col. 11, lines 5-15 and 31-52 and FIGS. 1B and 2.

As is apparent from the basic architecture of system described in FIGS. 1B and 2 of Williams, Bank Website 182 is an integral part of the system, and that system plainly requires communication with a financial institution when payment instruments are issued.

Moreover, the FIGS. 10-12 describe a preferred embodiment of a Payment Instrument and Authorization sequence in Williams, wherein bitmap images of the user's credit cards are used to

complete transactions. As described at col. 21, lines 32-34, the images "[are] virtually identical to the user's actual card[s], so such information as payment instrument holder's name, instrument name, membership period and expiration date" are displayed.

When a user of Williams uses a given payment instrument to pay for a product on a vendor's web site, a certificate associated with the payment instrument is transmitted from the user's computer to the vendor's web site. See, e.g., col. 13, line 35 to col. 14, line 23 and col. 36, lines 44-49. ***The certificate contains the user's personal and financial information such as the user's social security number, bank account numbers, and credit card numbers.*** See FIG. 29 and col. 36, lines 63-12. Accordingly, the Williams system requires that the user's personal information be disclosed to the vendor in connection ***with each purchase.***

Williams requires that the vendor interact with a financial institution when issuing payment instruments and further requires that the user's personal information be disclosed to the vendor in connection with each purchase.

(iv) The Hill Patent

Hill discloses a digital payment transaction system that is suitable for making micropayments. The system issues "to the user a 'carnet' or set of digital payment tokens which comprises a set of random number in a determined sequence. The numbers in the sequence are unrelated to one another, and there is no correlation between the numerical value of a token and its position in the sequence." Hill, column 2, lines 27-30.

To complete a purchase transaction, a user of the system described in Hill must first visit a Quickpay web site. The user establishes an account that enables the user to visit a

page where a Quickpay carnet may be purchased. The user selects a "Buy" option that creates a new Quickpay carnet and downloads the carnet to the user's client device. The user installs the carnet. The user may then use the carnet to purchase a summary of a document using a NetSumm homepage. The user specifies a uniform resource locator (URL) of a document to be summarized. Use of NetSumm, however, ***imposes a minimum user fee for each summary***. See, e.g., Hill, column 7, line 64 - column 8, line 19. "Use of NetSumm is charged at £0.002 (0.2 pence) per summary. Every time a page is submitted, NetSumm charges the user two Quickpay tokens before returning the result (the token value in this example is 0.1p)." Hill, column 8, lines 18-21. If a user desires to download hypertext markup language (HTML) pages of news items, for example, from a merchant, the merchant requests payment of, for example, 10p. Accordingly, users of the system described in Hill incur a minimum processing fee in connection with use of the system.

(v) The Claimed Invention is Not Obvious

Appellant respectfully submits that none of Dorrough, Williams or Hill, alone or in combination, teaches or suggests appellant's claimed features of (1) issuing electronic tokens from a vendor without requiring communication with a financial institution; (2) making purchases without disclosing the user's personal information to the vendor; and (3) enabling a purchase transaction that is not subject to a minimum processing fee as recited in claims 1 and 27. Instead, each of the above-cited references requires one or more features that are explicitly excluded from being present in the claims on appeal.

Although Hill discloses a system that uses tokens for making micropayments, Hill does not cure the deficiencies of either Dorrough or Williams with respect to authorizing a

purchase transaction at the participating vendor web site without requiring any third party authentication. Specifically, nothing in Hill teaches or suggests applicant's claimed method of enabling a vendor to issue electronic tokens wherein a purchase transaction is not subject to a minimum processing fee.

Moreover, Dorrough requires a physical manifestation of the account in the form of an access card that is scanned at each entertainment center to gain access to an activity. Williams expressly provides that the user information be provided to each vendor website in connection with each transaction. Hill explicitly requires both communication with a financial institution and imposes a minimum processing fee in connection with each transaction. Other than "convenience," the Office action is devoid of any suggestion as to why one of ordinary skill in the art would have been motivated to combine the disparate systems described in Dorrough, Williams and Hill to arrive at the system recited in appellant's claims. See Office action at page 4.

Much less does the Office action point to any suggestion in the prior art that would have lead one of ordinary skill to pick-and-choose amongst the specific elements disclosed in Dorrough, Williams and Hill to arrive at a system that would correspond to appellant's claimed invention. Neither Dorrough nor Williams would be operative without a physical manifestation of the account, in the form of an access card or bitmap image thereof. Other than hindsight gleaned from appellant's specification, what would have suggested to one of ordinary skill that a physical manifestation of the account should be omitted in the combined system allegedly "suggested" by Dorrough/Williams/Hill?

Likewise, each of the cited systems requires some personal identification (e.g., name) or credit information (credit card

number) be provided in connection with each transaction. Where would the motivation to omit this information in the combined Dorrough/Williams/Hill system have come from - if not in fact taken by the Examiner from appellant's own specification? The claims on appeal are not prima facie obvious. Neither does the Office action present any plausible argument why one of ordinary skill would have been motivated to modify and combine those disparate references to arrive at the claimed invention.

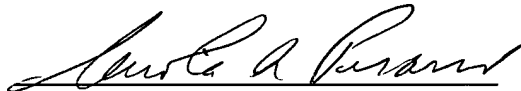
For the foregoing reasons, appellant respectfully submits that claims 1 and 27 patentably distinguish over the prior art of record. Appellant further submits that claims 2-26 and 28, which depend from claim 1, are allowable for at least the same reasons as claim 1.

Conclusion

In view of the foregoing, appellant respectfully submits that the pending claims are fully supported by the specification and patentably distinguish over the prior art. Appellant respectfully requests that the rejection under 35 U.S.C. § 103(a) be reversed and that the above-identified application be passed to issue.

Appellant respectfully requests that this appeal be decided on the issues presented and the prior art already of record. Appellant respectfully requests that prosecution **not** be reopened on this application yet again, after a second round of appeal fees and preparation and filing of appeal briefs, except to overturn the above rejections and to pass the case to issue.

Respectfully submitted,



Nicola A. Pisano
Registration No: 34,408
Attorney for Appellant

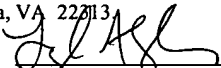
c/o LUCE, FORWARD,
HAMILTON & SCRIPPS, LLP
11988 El Camino Real, Suite 200
San Diego, California 92130
Tel.: 858.720.6320
Fax.: 858.523.4326

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Claims Appendix

1. A method of conducting electronic commerce over the Internet using micropayments, the method comprising:

opening a user account with a vendor for a user;

issuing one or more electronic tokens from the vendor to the user account, wherein no physical manifestation, other than a database entry, of the user account occurs, each electronic token having a value of at least a fraction of a dollar;

providing products and services that may be purchased from the vendor at micropayment levels, wherein prices for the products and services are listed in units of electronic tokens;

permitting the user to select, at any participating vendor web site, a subset of the products and services for purchase from the vendor;

computing at the participating vendor web site a total price for the selected subset of the products and services in units of electronic tokens;

authorizing a purchase transaction at the participating vendor web site without requiring any third party authentication and a physical manifestation of the user account; and

if the user account contains electronic tokens having a value equal to or greater than the total price, permitting the user to purchase the selected subset of the products and services without requiring the user to disclose personal information to the vendor, and subtracting the total price from the user account, wherein the purchase transaction is not subject to a minimum processing fee.

2. The method of claim 1, wherein issuing one or more electronic tokens from the vendor to the user comprises permitting the user to purchase the one or more electronic tokens from the vendor.

3. The method of claim 2, wherein permitting the user to purchase the one or more electronic tokens from the vendor comprises permitting the user to conduct an on-line transaction using a credit card to purchase the one or more electronic tokens.

4. The method of claim 2, wherein permitting the user to purchase the one or more electronic tokens from the vendor comprises permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens.

5. The method of claim 4, wherein permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to use a purchase order to purchase the one or more electronic tokens.

6. The method of claim 4, wherein permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to request to be billed for the one or more electronic tokens.

7. The method of claim 4, wherein permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to use phone, fax, mail, or e-mail to purchase the one or more electronic tokens.

8. The method of claim 4, wherein permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to purchase electronic tokens without using a credit card.

9. The method of claim 1, wherein issuing the one or more electronic tokens comprises setting a price for the one or more electronic tokens, the price determined by the vendor.

10. The method of claim 1, wherein opening a user account with a vendor comprises registering the user with the vendor.

11. The method of claim 10, wherein registering the user with the vendor comprises recording personal information about the user in a database maintained by the vendor.

12. The method of claim 11, wherein registering the user with the vendor comprises acquiring personal information about the user through off-line communications.

13. The method of claim 10, wherein opening a user account with the vendor further comprises issuing a predetermined minimum number of electronic tokens to the user.

14. The method of claim 1, further comprising issuing additional electronic tokens to the user.

15. The method of claim 14, wherein issuing additional electronic tokens to the user comprises permitting the user to purchase additional electronic tokens if the user account does not contain enough electronic tokens to cover the

total price of the selected subset of products and services.

16. The method of claim 14, wherein issuing additional electronic tokens to the user comprises permitting the user to purchase additional electronic tokens through an on-line transaction using a credit card, without disrupting a process of selecting products and services.

17. The method of claim 1, further comprising displaying a number of available electronic tokens in the user account on a computer screen.

18. The method of claim 1, wherein providing products and services that may be purchased through the vendor comprises providing software to be purchased or rented in exchange for electronic tokens.

19. The method of claim 18, wherein providing software to be purchased or rented comprises providing software that is rented for a limited time.

20. The method of claim 18, wherein providing software to be purchased or rented comprises providing software that is rented for a limited number of uses.

21. The method of claim 18, wherein providing software to be purchased or rented comprises providing software that is rented for processing a given task for a specific number of times.

22. The method of claim 18, wherein providing software to be purchased or rented further comprises permitting

the user to extend the software rental in exchange for electronic tokens.

23. The method of claim 18, wherein providing software to be purchased or rented further comprises permitting the user to convert rental software to purchased software in exchange for electronic tokens.

24. The method of claim 18, wherein providing software to be purchased or rented further comprises determining if a selected software program is already installed on a user's computer, downloading and installing the selected software program if the selected software program is not already installed on the user's computer, and sending an authorization code, without downloading the selected software program, if the selected software program is already installed on the user's computer.

25. The method of claim 1, further comprising transferring electronic tokens from the user to a second user.

26. The method of claim 1, wherein providing products and services that may be purchased through the vendor comprises listing products and services for sale by one or more users of a Web site maintained by the vendor.

27. A server operated by a vendor that provides products for sale or rental over the Internet, the server comprising:

a network interface through which the server communicates with a user over the Internet;

a database;

a memory;

a processor that executes software stored in the memory, the software including one or more programmed routines, the programmed routines comprising:

a registration routine that opens a user account with a vendor in the database for the user;

an electronic token sale routine that issues one or more electronic tokens from the vendor to the user account, wherein no physical manifestation, other than a database entry, of the user account occurs, each electronic token having a value of at least a fraction of a dollar;

a display routine that displays the prices of the products in units of electronic tokens;

a selection routine that permits the user to select, at any participating vendor web site, a subset of the products for purchase from the vendor without requiring the user to disclose personal information to the vendor, a total price of the subset of the products being computed in units of electronic tokens;

authorizing a purchase transaction at the participating vendor web site without requiring any third party authentication and physical manifestation of the user account;

a purchase routine that determines if the user account contains electronic tokens having a value equal to or greater than the total price, and if so, subtracts the total price from the user account, wherein the purchase transaction is not subject to a minimum processing fee; and

a download routine that enables the use to download the selected subset from the Internet.

28. The method of claim 10, wherein registering the user with the vendor enables the user to make purchases from at least one other vendor using registration information.

Evidence Appendix

None

Related Proceedings Appendix

None